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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,684	04/23/2001	Parkash S. Gill	017986-000420US	7332

26021 7590 07/31/2006

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EXAMINER

HOLLERAN, ANNE L

ART UNIT PAPER NUMBER

1643

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/743,684	<b>Applicant(s)</b> GILL, PARKASH S.	
	<b>Examiner</b> Anne L. Holleran	<b>Art Unit</b> 1643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,7,10,11,17-34,36-49 and 51-54 is/are pending in the application.  
4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,10,11,17-22,29-34,36-49,51 and 52 is/are allowed.
- 6) ☒ Claim(s) 7,53 and 54 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed 5/09/2006 is acknowledged. Claims 53 and 54 were added. Claim 50 was canceled.

Claims 24-28, drawn to non-elected inventions, are withdrawn from consideration.

Claims 6, 7, 10, 11, 17-23, 29-34, 36-49, and 51-54 are examined on the merits.

2. An IDS was submitted January 29, 2003 (and has an OIPE date of 2/3/2003, which the examiner referred to as the "filing date"). There is no corresponding 1449 for this IDS in this application. The lack of a corresponding 1449 may be due to Office error when the application was originally scanned, when the 1449 may have been lost. This IDS listed references that were cited in the parent application. Please see the "Remarks" section of the response filed 10/27/2004. Examiner acknowledges the 1449s submitted January 23, 2003 and February 13, 2002 and notes that they are present in the application.

#### ***Claim Rejections Withdrawn:***

3. The rejection of claim 7 under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polypeptides comprising the sequence DVCQD (SEQ ID NO: 28), where the polypeptide has anti-angiogenic activity, does not reasonably provide enablement for polypeptides comprising the sequence DXCXD, where X is any amino acid is withdrawn in view of the amendment to claim 7.

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4. The rejection of claims 6, 11, and 17-23 under 35 U.S.C. 102(e) as being anticipated by Hammerstedt (U.S. Patent 5,910,568; issued June 8, 1999; effective filing date Jan. 11, 1996; cited in the IDS) is withdrawn in view of the amendment to claim 11 limiting the size of the polypeptide to a maximum of 70 amino acids.
5. The rejection of claim 7 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment to claim 7.
6. The rejection of claims 6, 10, 11, 17-23, 29-34 and 36-52 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the amendment to claim 11.
7. The rejection of claims 6, 10, 11, 17-23, 29-34 and 37-52 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment to claim 11.
8. The rejection of claims 11, 17-23, 40 and 41 under 35 U.S.C. 102(b) as being anticipated by O'Brien (WO 95/03821; published 9 February 1995) is withdrawn in view of the amendment to claim 11.

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***New Grounds of Rejection:***

*The following New Grounds of Rejection are necessitated by amendment.*

9. Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 23 is drawn to an isolated polypeptide of claim 11, which has the amino acid sequence of SEQ ID NO: 13, 19, 21, 24, 25, 26 or 27. The word “has” is interpreted as open language, i.e. having the same scope as “comprising”. Claim 11, from which claim 23 is dependent, is limited to polypeptides that have at most 70 amino acids. Therefore, claim 23 encompasses polypeptide outside the scope of claim 11.

10. Claims 7 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite because the phrase “consisting of an amino acid sequence that is a part of SEQ ID NO: 2” is followed by the limitation that the polypeptide “has the sequence of SEQ ID NO: 28”. The word “has” is interpreted as open language, i.e. “comprising”. Therefore, claim 7 has two transitional phrases, a closed one followed by an open transitional phrase.

Claim 54 is indefinite because it is drawn to an isolated polypeptide comprising the sequence of SEQ ID NO: 45, where R' is defined as from “0 to about 59 contiguous amino

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acids”, but the maximum length of the polypeptide may only be 50 amino acids. Therefore, there appears to be a contradiction within the claim.

11. Claim 54 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claim 54 is drawn to an isolated polypeptide comprising the sequence of SEQ ID NO: 45, where the minimum length of the sequence is 7 amino acids and the maximum length of the polypeptide is 50 amino acids. The specification does not teach polypeptides comprising SEQ ID NO: 45 in the context of polypeptides having the size range of 7 to 50 amino acids in length. On page 3 of the originally filed disclosure SEQ ID NO: 45 is set forth with definitions for R, X and R', and the inherent range of lengths is 7 to 66 amino acids in length for polypeptides consisting of SEQ ID NO: 45. Because claim 54 is drawn to a subgenus of polypeptides having a range of sizes not originally contemplated, claim 54 introduces new matter into the specification as originally claimed.

12. Claim 53 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

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inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claim 53 is drawn to an isolated polypeptide comprising the sequence of SEQ ID NO: 28, wherein the polypeptide is between 5 and 11 amino acids in length and has anti-angiogenic activity. Thus, claim 53 is drawn to a subgenus of polypeptides where the minimum size is 5 amino acids and the maximum size is 11 amino acids in length. Applicant points to pages 2 and 3 of the specification as support for the amendments to the claims. However, the size range of 5 to 11 amino acids is not found in the passages pointed to by applicant. Therefore, the subgenus of claim 53 is new matter and claim 53 introduces new matter into the specification as originally filed.

13. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Hammerstedt (U.S. Patent 5,910,568; issued June 8, 1999; effective filing date Jan. 11, 1996; cited in the IDS).

The scope of claim 7 is indefinite because it contains a closed transitional phrase followed by an open transitional phrase. Therefore, in one interpretation, claim 7 appears to be drawn to a polypeptide of between 5 and 80 amino acids in length, wherein the polypeptide comprises SEQ ID NO: 28, which is a part of SEQ ID NO: 2. The specification teaches that polypeptides comprising SEQ ID NO: 28 have antiangiogenic activity.

Hammerstedt teaches a polypeptide of 80 amino acids in length that comprises SEQ ID NO: 28 and contains parts of SEQ ID NO: 2. Therefore, Hammerstedt teaches a polypeptide that is the same as that claimed.

***Conclusion***

Claims 6, 10, 11, 17-22, 29-34, 36-49, 51 and 52 are allowable. Claims 7, 23, 53 and 54 are not allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Holleran, whose telephone number is (571) 272-0833. The examiner can normally be reached on Monday through Friday from 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached on (571) 272-0832. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



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Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Official Fax number for Group 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Anne L. Holleran  
Patent Examiner  
July 24, 2006



LARRY R. HELMS, PH.D.  
SUPERVISORY PATENT EXAMINER